

REMARKS

The Office Action mailed May 21, 2004, has been carefully considered. Reconsideration in view of the following remarks is respectfully requested.

Rejection(s) Under 35 U.S.C. § 103 Rejection

Claims 1 – 3, 5, 7 – 10, 12 – 18 and 22 – 25 were rejected under 35 U.S.C. § 103(a) as unpatentable over Hanawa et al. (U.S. pat. no. 5,890,077) in view of Barber (U.S. pat. no. 6,230,031).

Claim 1 reads as follows:

1. A system comprising:
a radio modem unit; and
an RF signal booster unit, wherein the booster unit is connectable to the radio modem unit with a connector adapted to transmit RF signals, wherein a DC offset at the connector is detected to determine whether the booster unit is connected to the radio modem.

Claim 1 thus recites that the connector, through which RF signals are transmitted from the radio modem to the booster unit, is configured to carry a DC offset indicating whether the booster unit is connected to the radio modem. From a reading of the specification, and in particular the Background section thereof, it will be appreciated that this feature is an improvement over the prior art because it obviates the need to use separate connections, one for RF signal transmission from the radio modem to the booster, and the other for providing an indication of booster connection status. The problem with the prior art, which used two such connections, is that the additional status connector is inconvenient to the user, and could be forgotten, which would result in damage to the system.

It is respectfully submitted that Hanawa et al. is even further removed from the invention because Hanawa et al. does not disclose any RF connection between a modem and a booster. An RF connection in Hanawa et al. is simply unnecessary because the portable telephone 11 and the booster 12 each has its own transmitter/receiver and its own antenna. There is thus no need to send RF signals between these devices, since each device can transmit and receive RF signals on its own. Accordingly, the reason that Hanawa et al. generates a connected/disconnected signal as disclosed in FIG. 7 and the attendant discussion thereof is to enable control processor 94 to determine which SCMA class mark, one corresponding to the portable telephone, the other to the booster, should be sent to the base station. In this manner, the base station can properly identify from which device the user is currently communicating with the base station, so that correct power and other control signals can be transmitted from the base station to that device; otherwise, the user has to terminate the call from one device and re-establish the call using the other device when the user switches from one device to the other.

Hanawa et al.'s failure to use "a connector adapted to transmit RF signals, wherein a DC offset at the connector is detected to determine whether the booster unit is connected to the radio modem" (Claim 1) is not remedied by the combination with Barber, since Barber teaches the use of separate connections. In particular, Barber describes the disclosed connections used as follows:

The connections between the radio transceiver 30, the holder 32, and the booster amplifier 40 include, at least, signaling connections and a coaxial cable for passing RF signals to and from the radio transceiver 30. (Emphasis added).

Barber, col. 4, ll. 3 – 6.

Thus even if the Hanawa et al. system, which discloses a dedicated switch for indicating when two portable telephone devices each having its own transmitters/receivers and its own

antenna are connected, were properly combinable with Barber, which shows a booster unit for connection with a wireless telephone via separate RF coaxial connections (cable 74) and signaling connections (76), the result would not be “a connector adapted to transmit RF signals, wherein a DC offset at the connector is detected to determine whether the booster unit is connected to the radio modem” as presently claimed. Rather the result would be the separate RF coaxial connections and signaling connections of Barber and the dedicated connection of Hanawa et al.. In other words, there is simply no suggestion in either of these references that some of these connections could be combined, and that the presently claimed arrangement could be achieved. The contention that combination could be made is grounded in impermissible hindsight based on a review of Applicant’s disclosure. Such a basis for an obviousness rejection is impermissible, and withdrawal of same is respectfully requested.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.¹

Applicants respectfully submit that these criteria for a proper 35 U.S.C. § 103(a) rejection have not been met, and the rejection based on the combination of Hanawa et al. and Barber is therefore improper and should be withdrawn.

Similar arguments hold for Claims 8, 13, 19 and 22, and the remaining claims dependent therefrom. For example, Claim 8 recites “a detector unit adapted to detect a DC offset at the [RF

signal] connector to determine whether the connector is connected to a booster unit.” For at least the same reasons, it is therefore respectfully submitted that the rejection of the remaining claims based on the combination of Hanawa et al. and barber is improper and should be withdrawn.

Conclusion

In view of the preceding discussion, Applicants respectfully urge that the claims of the present application define patentable subject matter and should be passed to allowance. Such allowance is respectfully solicited.

If the Examiner believes that a telephone call would help advance prosecution of the present invention, the Examiner is kindly invited to call the undersigned attorney at the number below.

¹ M.P.E.P § 2143.

Please charge any additional required fee, including those necessary to obtain extensions of time to render timely the filing of the instant Reply, or credit any overpayment not otherwise paid or credited, to our deposit account No. 50-1698.

Respectfully submitted,
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